

**REMARKS**

[0001] Claims 1-2, 4-5, 7, 15-16, 18-19, 22-31, 33-35, 49-57, 59-62, 64, 66-67, 69-70 are all the claims presently pending in this application. Claims 1, 15, 22, 25-26, 33, 35, 49, 52-53, 59, 61-62, 64, 67 and 69-70 have been amended to more particularly define the claimed invention.

[0002] Applicant respectfully submits that entry of the currently amended claims is proper because the currently amended claims will either place the application in condition for allowance or in better form for appeal. Applicant further respectfully submits that no new matter is added to the currently amended claims, nor has the scope of the pending claims changed. Accordingly, no new issues are raised that necessitate a further search of art. Applicant respectfully traverses the rejections based on the following discussion.

**I. THE PRIOR ART REJECTIONS**

**A. The 35 U.S.C. § 103(a) Rejection over Fajkowski**

[0003] Claims 1-2, 4-5, 7, 15-16, 18-19, 21-31, 33, 35, 49-57, 59, 61, 62 and 66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fajkowski, U.S. Pat. No. 6,932,270, (hereinafter "Fajkowski").

[0004] The Examiner alleges that one of ordinary skill in the art would have been motivated to modify Fajkowski to form the invention of claims 1-2, 4-5, 7, 15-16, 18-19, 21-31, 33, 35, 49-57, 59, 61-62 and 66. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0005] Applicant's traverse the Examiner's rejection since, among other reasons, Fajkowski to



describes using a coupon card contained a plurality of coupon bar codes that is inserted into a periphery device before checkout to determine what coupons are redeemable against the consumer's anticipated purchases, while Applicant's claimed invention claims *determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase*, and *outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons*.

[0006] More specifically, Applicant submits, that Fajkowski fails to teach or suggest:

*“checking said selection of e-coupons complying with said redeeming conditions to determine mutually exclusive e-coupons of said selection of e-coupons applicable within said purchase, and to determine if two or more non-mutually exclusive e-coupons of said selection of e-coupons can be used in combination within said purchase,”*

*“performing an optimization process...determining a most favorable combination of non-mutually exclusive e-coupons,”*

*“outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons,”*

according Applicant's independent claim 1, and similarly independent claims 15, 22, 49 and 62.

[0007] Fajkowski discloses that a coupon card allows users to scan large numbers of coupon bar codes directly from a Free Standing Insert (FSI) containing the coupons, thus completely eliminating the necessity of clipping out, sorting and transporting a large number of paper coupons. (Column 4, lines 9-13.) During checkout, a consumer inserts the coupon card into a periphery device that reads the coupon bar codes from the coupon card and the periphery device receives data from the cash register indicating what products were purchased by the consumer. The periphery device compares the data received from the cash register and the bar codes on the



coupon card to determine what coupons are redeemable against the consumer's purchases. A list of redeemable coupons will then be displayed on the periphery device. (Column 4, lines 26-35.)

[0008] Fajkowski further discloses using the operational keys on the periphery device, the cashier may take care of any concerns the consumer has about the list of redeemable coupons. For example, the cashier may search.... In the appropriate situation, the cashier may use an "override" operational key.... Other operational keys discussed herein will allow additional functions to be carried out by the periphery device. When a final list of redeemed coupons is agreed upon, the list will be transferred to the cash register for crediting against the consumer's purchases. Finally, the periphery device will remove the coupons which were redeemed from the memory of the coupon card. (Column 4, lines 36-53.)

[0009] The Examiner states on pages 5, 10 and 18 that, "it would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed non-compliant coupons for any noncompliant criteria including the suggested mutually exclusive criteria above." Applicant respectfully traverse this motivation to modify the Fajkowski reference since nowhere in Fajkowski is there any disclosure of, "determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase," and subsequently, "outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons."

[0010] In summary, Fajkowski to describes using a coupon card contained a plurality of coupon bar codes that is inserted into a periphery device before checkout to determine what coupons are redeemable against the consumer's anticipated purchases, while Applicant's claimed invention claims determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase, and outputting a suggestion to said user displaying said most favorable combination



*of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons.*

[0011] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art reference to Fajkowski fails to teach or suggest each element and feature of Applicant's claimed invention.

**B. The 35 U.S.C. § 103(a) Rejection over Fajkowski further in view of Beach**

[0012] Claims 34, 60 and 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fajkowski, further in view of Beach et al., U.S. Pat. App. Pub. No. US2002/10107738, (hereinafter "Beach").

[0013] The Examiner alleges that one of ordinary skill in the art would have been motivated to modify Fajkowski with the teaching from Beach to form the invention of claims 34, 60 and 64. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention. That is, Beach fails to make up for the deficiencies of Fajkowski as discussed above.

[0014] The Examiner asserts Beach "teaches user collection of ecoupons which are redeemed at the POS."

[0015] However, even assuming arguendo that the Examiner's position has some merit, Beach fails to teach or suggest, "*determining if said computed set of e-coupons complies with one or more redeeming conditions, which of said set of e-coupons are mutually exclusive within a same purchase and which of said set of e-coupons are non-mutually exclusive to be used in combination within the same purchase,*" and subsequently, "*outputting a suggestion to said user*



*displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons,*” of Applicant’s independent claims 22, 49 and 62, respectively. Therefore, Beach fails to overcome the deficiencies of Fajkowski.

[0016] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Fajkowski and Beach (either alone or in combination) fail to teach or suggest each element and feature of Applicant’s claimed invention.

**C. The 35 U.S.C. § 103(a) Rejection over Fajkowski further in view of Marmon**

[0017] Claims 1-2,4-5,7,15-16,18-19,21-31,33,35,49-57,59,61,62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, further in view of Marmon, U.S. Pat. No. 4,446,528, (hereinafter “Marmon”).

[0018] The Examiner alleges that one of ordinary skill in the art would have been motivated to modify Fajkowski with the teaching from Marmon to form the invention of claims 1-2,4-5,7,15-16,18-19,21-31,33,35,49-57,59,61,62 and 66. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0019] Applicant’s traverse the Examiner’s rejection since, among other reasons, Fajkowski to describes using a coupon card contained a plurality of coupon bar codes that is inserted into a periphery device before checkout to determine what coupons are redeemable against the consumer’s anticipated purchases, while Applicant’s claimed invention claims *determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase*, and *outputting a suggestion to said user displaying said most favorable combination of non-mutually*



*exclusive e-coupons based on said determining said mutually exclusive e-coupons.*

[0020] More specifically, Applicant submits, that Fajkowski fails to teach or suggest:

*“checking said selection of e-coupons complying with said redeeming conditions to determine mutually exclusive e-coupons of said selection of e-coupons applicable within said purchase, and to determine if two or more non-mutually exclusive e-coupons of said selection of e-coupons can be used in combination within said purchase,”*

*“performing an optimization process...determining a most favorable combination of non-mutually exclusive e-coupons,”*

*“outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons,”*

according Applicant’s independent claim 1, and similarly independent claims 15, 22, 49 and 62.

[0021] The Examiner states on pages 5, 10 and 18 that, “it would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed non-compliant coupons for any noncompliant criteria including the suggested mutually exclusive criteria above.” Applicant respectfully traverse this motivation to modify the Fajkowski reference since nowhere in Fajkowski is there any disclosure of, “determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase,” and subsequently, “outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons.”

[0022] The Examiner alleges that Marmon “teaches that shopping can get quite complicated when pricing systems are combined with cents off coupons and retailers offer to double or triple coupons,” “that the consumer is confronted with many price-affecting choices related to coupons and that he usually is seeking low prices,” and that “Marmon is actually closely related with



coupon decision making and suggesting coupon usage that would be optimum for the user.”

[0023] However, nowhere in Marmon is there any teaching or suggestion of, “*determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase,*” and subsequently, “*outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons.*” Therefore, Marmon fails to overcome the deficiencies of Fajkowski.

[0024] In summary, Fajkowski describes using a coupon card contained a plurality of coupon bar codes that is inserted into a periphery device before checkout to determine what coupons are redeemable against the consumer’s anticipated purchases, while Applicant’s claimed invention claims *determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase,* and *outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons.*

[0025] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Fajkowski and Marmon (either alone or in combination) fail to teach or suggest each element and feature of Applicant’s claimed invention.

**D. The 35 U.S.C. § 103(a) Rejection over Fajkowski further in view of Wilkman**

[0026] Claims 1-2,4-5,7,15-16,18-19,21-31,33,35,49-57,59,61,62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, further in view of Wilkman, U.S. Pat. App. Pub. No. 20020013728, (hereinafter “Wilkman”).

[0027] The Examiner alleges that one of ordinary skill in the art would have been motivated to



modify Fajkowski with the teaching from Wilkman to form the invention of claims 1-2,4-5,7,15-16,18-19,21-31,33,35,49-57,59,61,62 and 66. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0028] Applicant's traverse the Examiner's rejection since, among other reasons, Fajkowski to describes using a coupon card contained a plurality of coupon bar codes that is inserted into a periphery device before checkout to determine what coupons are redeemable against the consumer's anticipated purchases, while Applicant's claimed invention claims *determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase*, and *outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons*.

[0029] More specifically, Applicant submits, that Fajkowski fails to teach or suggest:

*“checking said selection of e-coupons complying with said redeeming conditions to determine mutually exclusive e-coupons of said selection of e-coupons applicable within said purchase, and to determine if two or more non-mutually exclusive e-coupons of said selection of e-coupons can be used in combination within said purchase,”*

*“performing an optimization process...determining a most favorable combination of non-mutually exclusive e-coupons,”*

*“outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons,”*

according Applicant's independent claim 1, and similarly independent claims 15, 22, 49 and 62.

[0030] The Examiner alleges that Wilkman “recognizes the variety of incentive offers available to purchasing consumers and he teaches the use of a computer-based optimization routine that



takes the legwork out of manually analyzing the variety of eligible combinations and benefits (price, coupons, promotions, loyalty, etc.) in order to provide the best benefit for the consumer.”

[0031] However, nowhere in Wilkman is there any teaching or suggestion of, “*determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase*,” and subsequently, “*outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons*.” Therefore, Wilkman fails to overcome the deficiencies of Fajkowski.

[0032] In summary, Fajkowski describes using a coupon card contained a plurality of coupon bar codes that is inserted into a periphery device before checkout to determine what coupons are redeemable against the consumer’s anticipated purchases, while Applicant’s claimed invention claims *determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase*, and *outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons*.

[0033] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Fajkowski and Wilkman (either alone or in combination) fail to teach or suggest each element and feature of Applicant’s claimed invention.

**E. The 35 U.S.C. § 103(a) Rejection over Fajkowski further in view of Wilkman**

[0034] Claims 34, 60 and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski and Wilkman, further in view of Beach.

[0035] The Examiner alleges that one of ordinary skill in the art would have been motivated to



modify Fajkowski with the teaching from Wilkman to form the invention of claims 1-2,4-5,7,15-16,18-19,21-31,33,35,49-57,59,61,62 and 66. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention. That is, Wilkman fails to make up for the deficiencies of Fajkowski and Wilkman as discussed above.

[0036] The Examiner asserts Beach “teaches user collection of ecoupons which are redeemed at the POS.”

[0037] However, even assuming arguendo that the Examiner's position has some merit, Beach fails to teach or suggest, “*determining if said computed set of e-coupons complies with one or more redeeming conditions, which of said set of e-coupons are mutually exclusive within a same purchase and which of said set of e-coupons are non-mutually exclusive to be used in combination within the same purchase,*” and subsequently, “*outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons,*” of Applicant's independent claims 22, 49 and 62, respectively. Therefore, Beach fails to overcome the deficiencies of Fajkowski and Wilkman.

[0038] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Fajkowski, Wilkman and Beach, (either alone or in combination), fail to teach or suggest each element and feature of Applicant's claimed invention.



**F. The 35 U.S.C. § 103(a) Rejection over Fajkowski further in view of Wilkman**

[0039] Claims 1-2,4-5,7,15-16,18-19,21-31,33,35,49-57,59,61,62 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski further in view of Wilkman further in view of Marmon.

[0040] The Examiner alleges that one of ordinary skill in the art would have been motivated to modify Fajkowski with the teaching from Wilkman to form the invention of claims 1-2,4-5,7,15-16,18-19,21-31,33,35,49-57,59,61,62 and 66. Applicant submits, however that these references would not have been combined and even if combined, the combination would not teach or suggest each element of the claimed invention.

[0041] Applicant's traverse the Examiner's rejection since, among other reasons, Fajkowski to describes using a coupon card contained a plurality of coupon bar codes that is inserted into a periphery device before checkout to determine what coupons are redeemable against the consumer's anticipated purchases, while Applicant's claimed invention claims *determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase*, and *outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons*.

[0042] More specifically, Applicant submits, that Fajkowski fails to teach or suggest:

*“checking said selection of e-coupons complying with said redeeming conditions to determine mutually exclusive e-coupons of said selection of e-coupons applicable within said purchase, and to determine if two or more non-mutually exclusive e-coupons of said selection of e-coupons can be used in combination within said purchase,”*

*“performing an optimization process...determining a most favorable combination of non-*



*mutually exclusive e-coupons,”*

*“outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons,”*

according Applicant’s independent claim 1, and similarly independent claims 15, 22, 49 and 62.

[0043] The Examiner states on pages 5, 10 and 18 that, “it would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed non-compliant coupons for any noncompliant criteria including the suggested mutually exclusive criteria above.” Applicant respectfully traverse this motivation to modify the Fajkowski reference since nowhere in Fajkowski is there any disclosure of, “*determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase,*” and subsequently, “*outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons.*”

[0044] The Examiner alleges that Wilkman “recognizes the variety of incentive offers available to purchasing consumers and he teaches the use of a computer-based optimization routine that takes the legwork out of manually analyzing the variety of eligible combinations and benefits (price, coupons, promotions, loyalty, etc.) in order to provide the best benefit for the consumer.”

[0045] Additionally, the Examiner alleges that Marmon “teaches that shopping can get quite complicated when pricing systems are combined with cents off coupons and retailers offer to double or triple coupons,” “that the consumer is confronted with many price-affecting choices related to coupons and that he usually is seeking low prices,” and that “Marmon is actually closely related with coupon decision making and suggesting coupon usage that would be optimum for the user.”

[0046] However, nowhere in Wilkman nor Marmon is there any teaching or suggestion of,



*“determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase,” and subsequently, “outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons.”* Therefore, neither Wilkman nor Marmon overcome the deficiencies of Fajkowski.

[0047] In summary, Fajkowski to describes using a coupon card contained a plurality of coupon bar codes that is inserted into a periphery device before checkout to determine what coupons are redeemable against the consumer’s anticipated purchases, while Applicant’s claimed invention claims *determining mutually exclusive e-coupons of a selection of e-coupons applicable within a purchase*, and *outputting a suggestion to said user displaying said most favorable combination of non-mutually exclusive e-coupons based on said determining said mutually exclusive e-coupons*.

[0048] Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection since the alleged prior art references to Fajkowski and Wilkman (either alone or in combination) fail to teach or suggest each element and feature of Applicant’s claimed invention.

## **II. FORMAL MATTERS AND CONCLUSION**

[0049] In view of the foregoing, Applicant submits that claims 1-2, 4-5, 7,15-16, 18-19, 22-31, 33-35, 49-57, 59-62, 64, 66-67, 69-70, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

[0050] Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to



Application No. 09/772,244  
Docket No. JP920000376US1

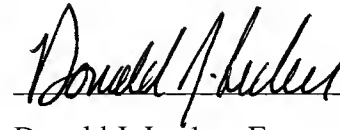
29

discuss any other changes deemed necessary in a telephonic or personal interview.

[0051] The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0441.

Date: December 10, 2008

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Donald J. Lecher", written over a horizontal line.

Donald J. Lecher, Esq.  
Registration No. 41,933

**GIBB IP LAW FIRM, LLC**  
2568-A Riva Road, Suite 304  
Annapolis, Maryland 21401  
Voice: 410-573-6501  
Fax: 301-261-8825  
E-mail: Lecher@gibbiplaw.com  
**Customer No. 29154**